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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,054	08/26/2003	Rolf Bruck	E-80656	7377

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EXAMINER

KENNY, STEPHEN

ART UNIT PAPER NUMBER

3726

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/650,054

**Applicant(s)**

BRUCK, ROLF

**Examiner**

Stephen J Kenny

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/26/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, & 23, drawn to a method of producing a honeycomb body, classified in class 29, subclass 890.
- II. Claims 11-15, drawn to an apparatus for producing a honeycomb body, classified in class 29, subclass 701.
- III. Claims 16-22, drawn to a honeycomb body, classified in class 428, subclass 116.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of Group I does not require signal lines connecting a memory to perforation and identification units.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a process that does not require a hole memory device.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Lawrence Greenburg on November 8, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10, & 23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 32-33 state that the steps b), c), d), and e) can be performed in any order. It is unclear to the examiner how step d), for example, can be performed step b). In other words one must have "identified" or obtained a sheet metal layer before constructing a hole therein.

Claim 1, step f) is a circular reference.

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Claim 1, steps e), g), and h) contain the phrase “if required”, therefore applicant has not positively recited any stated method steps. As such it is unclear to the examiner how these optional steps alter the claimed method.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

As best understood by the examiner in light of the USC 112 rejection above, claims 1- 8, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Toshiaki (JP 01012018).

Regarding claim 1, Toshiaki discloses forming a honeycomb structure having a measurement sensor (40) and sheet metal layers forming a body structure (21) which allowing fluid to flow through the body structure, the body having a cohesive free volume (50) receiving said measurement sensor (40) comprising: selecting a section of sheet metal strip from a supply roll (22), reading/identifying a hole position & edge (50-52) from a memory (i.e. “specified intervals” implies that the positions are measured and predetermined, and therefore are from “memory”) to be formed in the sheet metal, constructing the holes & edges (50-52) at the associated hole position, repeating this process for the desired number of layers, winding said sheets into a honeycomb structure, introducing the structure into a casing tube (11), introducing the measurement sensor (40) into the structure & tube (see Figures 1, -5).

Regarding claims 2-8, Toshiaki discloses the hole positions forming a cohesive cavity in the honeycomb body having a geometry which corresponds to the sensor's dimensions (40) (Figure 1). It is inherent that the cavity be larger by a predetermined tolerance (gathered both from empirical data i.e. measurements, and formed in a mathematical model to match different sensors sizes to different hole configurations) in order for the sensor to be accepted within the cavity. If the cavity were formed too small, the sensor would not fit within the honeycomb body making the structure useless, meanwhile if the cavity were formed too large the sensor would not mount properly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In alternative to the USC 102(b) rejection above claims 1-10, & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki in view of Sato et al (US Patent No. 6761980).

Toshiaki discloses the claimed invention except for explicitly stating that the hole positions are formed from "memory".

Sato discloses forming a variety of hole (13, 16, 21) shapes and positions in a honeycomb structure (Figures 6-8). Such holes are formed depending on the particular application of the honeycomb structure, and are formed at "prescribed" locations – in other words, they are formed

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from “memory”. Forming a honeycomb structure having a plurality of hole types/positions from “memory” is advantageous in that it provides greater manufacturing flexibility to accommodate a variety of applications. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a honeycomb structure as disclosed by Toshiaki by forming the holes from “memory” as taught by Sato.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki.

Toshiaki discloses the claimed invention except for explicitly stating that the holes are of an oval shape, and the sensor is an HC or lambda sensor. It would have been an obvious matter of design choice to form oval holes, and use such a sensor, since applicant has not disclosed that such a hole/sensor solves any stated problem or is for any particular purpose, and it appears that the invention would perform equally well with the hole/sensor of Toshiaki.

### *Conclusion*

The prior art made of record on the attached PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J Kenny whose telephone number is 703-306-0359. The examiner can normally be reached on mon - fri 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sk

*S. Kenny*

*11/10/04*



**DAVID P. BRYANT  
PRIMARY EXAMINER**